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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM B. FRANKLIN and THOMAS W. OLIVER

Appeal 2007-2882
Application 09/676,445
Technology Center 2600

Decided: January 7, 2008

Before KENNETH W. HAIRSTON, ROBERT E. NAPPI, and JOHN A. JEFFERY, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 6(b) of the final rejection of claims 1 through 22, 24 through 31, and 33.

We reverse the Examiner's rejections of these claims.

INVENTION

The invention is directed to a method of creating a web page containing an electronic version of a catalog where the catalog was previously printed from a vector graphics file. See pages 2, 3 and the

Abstract of Appellants' Specification. Claim 1 is representative of the invention and reproduced below:

1. A method of creating an electronic catalog web page and a catalog printed on paper from a vector graphics data file comprising
printing the catalog on paper from the vector graphics data file;
converting the vector graphics data file from its native file format to a bit map graphics file format;
modifying the bitmap graphics data file by converting cyan, magenta, yellow, black (CMYK) color values to red, green, blue (RGB) color values;
inserting the modified bit map graphics data file into the electronic catalog web page; and
making the electronic catalog web page available on the Internet for members of the public to view on a computer monitor so as to select one or more pages of interest from the electronic catalog and print selected pages on an RGB desktop printer after the catalog has been printed on paper from the vector graphics data file.

REFERENCES

Aitkens	US 5,380,044	Jan. 10, 1995
King	US 5,956,737	Sep. 21, 1999
Silverbrook	US 5,984,446	Nov. 16, 1999
Laverty	US 6,429,947 B1	Aug. 6, 2002
Davis	US 6,552,732 B1	Apr. 22, 2003
Chase	US 6,611,348 B1	Aug. 26, 2003

REJECTIONS AT ISSUE

Claims 1 through 10, 14 through 22, 24 through 31, and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Laverty in view of Chase, Silverbrook, Davis, and Aitkens. The Examiner's rejection is on pages 3 through 52 of the Answer.

Claims 11 through 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lavery in view of Chase, Silverbrook, Davis, Aitkens and King. The Examiner's rejection is on pages 52 and 53 of the Answer.

Throughout the opinion, we make reference to the Brief (received August 29, 2006) and the Answer (mailed December 22, 2006) for the respective details thereof.

ISSUES

Appellants contend that the Examiner's rejection of claims 1 through 10, 14 through 22, 24 through 31, and 33 under 35 U.S.C. § 103(a) is in error. On pages 13 through 21 of the Brief, Appellants present several arguments asserting that the combination of Lavery in view of Chase, Silverbrook, Davis, Aitkens, does not teach the claimed feature of "public availability over the internet," RGB [Red Green Blue] printing" and "Text error correction." Appellants reason that Lavery and Chase make use of private communication over the Internet and, as such, do not teach the claimed step of "making the electronic catalog web page available on the Internet for members of the public to view on a computer monitor." Brief 13-14.

Thus, Appellants' contentions present us with several issues. However, the dispositive issue is whether the combination of the references teaches the claim limitation of making an electronic catalog available over the Internet to the public as claimed.

FINDINGS OF FACT

1. Lavery teaches an on-line printing system, in which a user can set up and order a printed product over the Internet. Abstract, col. 8, ll. 50-54.
2. The system automates the order processing. The system also provides a proof file (an image of the product to be printed) for the user to review prior to approval for printing. When approved the system provides a print ready file (PRF) to a printer to produce the printed product. Lavery, col. 7, ll. 23-26, col. 8, ll. 54-61.
3. The proof file is created as a Portable Document Format (PDF) file and sent to the user via the Internet. The PDF file can be viewed, navigated, printed, or forwarded. Lavery, col. 11, ll. 4-15, col. 15, 10-13.
4. The proof file is sent to the user for viewing prior to the printing of the product. See Lavery's overall flow diagram, Fig. 13, preview step 910 and approval/order steps 911/912 occur prior to printing step 922.
5. An order is placed through a customer web site that is set up based upon information relating to the product the user desires. The web site is then accessed to order printed products. Lavery, fig 14, col. 20, ll. 20-25, col. 31, ll. 34-44.
6. Lavery describes the customer as being a business (i.e. either an entity or an individual), thus suggesting that the customer web page may be accessed by more than one person. However, we find no discussion in Lavery that the customer web page is available to others.

7. Chase teaches a printing and publishing system where the central facility communicates with an end-user facility (which creates files of pages to be printed) and printing company's facility (which prints the files created). Abstract, col. 2, ll. 53-60.
8. Chase's system makes use of the Internet (described as a public network) to provide communication between the facilities. However, only subscribers to the printing and publishing system can access the information in the system over the Internet (public network). Col. 5, ll. 9-20.
9. Chase's system allows the end user to view a proof copy of the document to be printed. The proof is provided, as a PDF file, over the network to the end user facility and can be printed on a proofer (four color, digital color printer). Col 7, ll. 17-20, 52-65, col. 11, ll. 33-44.
10. Aitkens teaches a method of making identification cards where a Red, Green, Blue (RGB) printer is used. Abstract, col. 7, l. 15.
11. Silverbrook teaches a high speed color printer. The printer may be a six color printer, 2/3 density cyan, 1/3 density cyan, 2/3 density magenta, 1/3 density magenta, yellow, and black (CC'MM'YK), and can print vector graphics files. Abstract, col. 4, ll. 56-67, col. 50, ll. 17-20.
12. Davis teaches a method of using vector graphics files, in lieu of bit map data files in web pages transmitted over the Internet. Abstract, col. 1, ll. 19-30, col. 1 l. 66- col. 2, l. 13.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”). The Court in *Graham* further noted that evidence of secondary considerations, such as commercial success, long felt but unsolved needs, failure of others, etc., “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Graham* 383 U.S. at 17-18.

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *Id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248 [(1850)].” *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The operative question in this “functional

approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740. “[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *Id.* at 1740 (citing *Sakraida v. AG Pro, Inc.*, 425 U. S. 273, 282 (1976)).

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976). In order to meet the written description requirement, the Appellant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). Finally, "[p]recisely how close the original description must come to comply with the description requirement of § 112 must be determined on a case-by-case basis." *Eiselstein v. Frank*, 52 F.3d 1035, 1039 (Fed. Cir. 1995) (quoting *Vas-Cath*, 935 F.2d at 1561).

ANALYSIS

Appellants’ arguments have persuaded us of error in the Examiner’s rejection. Independent claim 1 recites, printing a catalog, and “making the electronic catalog web page available on the Internet for members of the

public to view on a computer monitor so as to select one or more pages of interest from the electronic catalog and print selected pages on an RGB desktop printer after the catalog has been printed on paper from the vector graphics data file.” Appellants’ Specification does not define the term “public,” but on page 4, lines 16-22, it is clear that the web page is to provide information to any potential customer. Further, we note that it is generally accepted that “public” means “not private.” Thus, the scope of claim 1 includes a web page, that includes a catalog that is available to the public (i.e. not private), after the catalog has been printed. Independent claims 25 through 31 and 33 recite similar limitations.

The Examiner states on pages 54 through 56 of the Answer that Lavery and Chase make use of a web page on the Internet and, as such, provide the catalog to the public. Further, the Examiner states, on page 56 of the Answer “the catalogs on the Internet inherently means that they are available for the general public to view.” While we agree with the Examiner’s findings that both Lavery and Chase make use of the Internet to transmit proof images, we disagree with the Examiners conclusion that this meets the claimed step of making the catalog available to the public. Both Lavery and Chase are similar in that they both provide printing services over the Internet. Facts 1 and 8. The web page in each of these references is a web page by which a user orders a printed product, this web page can be used to provide a proof of the product to be printed. Facts 2 and 9. While the Internet is used to transmit the web page which contains the proof, we note that both references discuss access to the web page being limited, Lavery limits access to customers and Chase limits access to subscribers. Facts 5, 6 and 8. Further, the proof or page layout file ,which the Examiner

considers to correspond to the catalog (see Answer pp. 54-56) is available prior to the printer printing the document not after as claimed. Facts 4 and 9. Thus, we do not find that the Evidence supports the Examiner's finding that Chase and Lavery teach the claimed step of making the electronic catalog available to the public.

The Examiner has not found, nor do we find that Silverbrook, Davis, or Aitkens, teaches or suggests modifying Lavery and Chase to include the feature of this limitation. Accordingly, we will not sustain the Examiner's rejection of claims 1 through 10, 14 through 22, 24 through 31, and 33 under 35 U.S.C. § 103(a).

Claims 11 through 13 are dependent upon claim 1. The Examiner has not found, nor do we find that the additional disclosure of King teaches or suggests modifying Lavery, Chase, Silverbrook, Davis and Aitkens to include the claimed step of making the electronic catalog available to the public as discussed above. Accordingly, we will not sustain the Examiner's rejection of claims 11 through 13 under 35 U.S.C. § 103(a).

NEW GROUND OF REJECTION

We now enter a rejection of claims 1 through 22, 24 through 31, and 33 under 35 U.S.C. § 112, first paragraph as not being supported by an adequate written description. Independent claims 1, 25 through 31, and 33 each recite a limitation directed to printing selected pages on an RGB (Red, Green, and Blue) printer. We do not find any discussion of this feature in Appellants' originally filed Specification, claims, or drawings. Further, Appellants' Brief¹ does not identify where in the originally filed disclosure

¹ In accordance with 37 C.F.R. § 41.37(c)(1)(v), Appellants' Brief is to identify where the originally filed Specification provides support for each

this feature is described. Thus, we do not find evidence on record to show that at the time of filing of this application, Appellants had possession of the claimed invention. Accordingly, we now reject claims 1 through 22, 24 through 31, and 33 under 35 U.S.C. § 112, first paragraph.

CONCLUSION

We consider the Examiner's rejections of claims 1 through 22, 24 through 31, and 33 under 35 U.S.C. § 103(a) to be in error. However, we enter a new rejection of claims 1 through 22, 24 through 31, and 33 under 35 U.S.C. § 112, first paragraph.

limitation.

ORDER

For the foregoing reasons, we will not sustain the Examiner's rejections under 35 U.S.C. § 103. The decision of the Examiner is reversed.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Appeal 2007-2882
Application 09/676,445

REVERSED - 37 C.F.R. § 41.50(b)

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